

Appl. No.: 10/075,580
Amtd. Dated: 04 October 2004
Reply to Office Action mailed 05/04/2004

REMARKS/ARGUMENTS

In the Office Action mailed 05/04/2004, marked FINAL, the Examiner has rejected claims 1-20 under 35 U.S.C.103(a) as being unpatentable over Penney (US 471,891) in view of Everett (US 5,896,955). In rejecting the claims in this Office Action the Examiner refers to discussions of Penney and Everett in previous Office Actions. In the previous Office Actions the Examiner has stated as follows:

(1) Office Action mailed 11/22/2002 wherein the claims were rejected over Everett in view of Penney.

- (a) The claimed invention differs from Everett only in the means for attaching the pads to the support;
- (b) Penney shows a brake support having pads B which slide into a groove and are locked into the support by a pin f; and
- (c) It would have been obvious to one of ordinary skill in the art to have utilized a mounting system for the pads, such as shown by Penney, in the shoe of Everett so as to more easily change pads.

(2) Office Action mailed 05/21/2003 marked FINAL wherein the amended claims are now rejected over Penney in view of Everett.

- (a) Penney shows a brake assembly of the type claimed having plural pads B slidably fit into shoe body A;
- (b) The claimed invention differs only in the intended use and in using pads having varying braking characteristics;
- (c) Everett shows a bicycle brake having plural interchangeable pads of varying braking characteristics; and
- (d) It would have been obvious to have utilized a brake such as shown by Penney for a bicycle in view of the teachings of Everett and use pads having different braking characteristics in so as use the brake for a variety of conditions as taught by Everett.

(3) Office Action mailed 10/07/2003 marked wherein the twice amended claims were rejected over Penney in view of Everett.

- (a) Note the previous discussions in paragraph 2 and 3 of paper number 5. Penney shows individual shoes in abutting relationship;
- (b) Re-claim 10. Note locking components F and abutment at D;
- (c) Re-claim 15. Penney teaches conforming the shoes to the wheel sidewall.

(4) Office Action mailed 05/04/2004 marked FINAL wherein the thrice amended claims were rejected over Penney in view of Everett.

(a) Note the previous discussion of Penney and Everett.

It is thus seen that the thrust of the Examiner's rejections are summarized in (2)d above, that is, "It would have been obvious to have utilized a brake such as shown by Penney for a bicycle in view of the teachings of Everett and use pads having different braking characteristics in so as use the brake for a variety of conditions as taught by Everett." Rejection of applicant's claims on this basis is respectfully traversed in that:

(1) Applicant submits, and has submitted, that the combination of the references of Penney and Everett to show applicant's claimed invention is improper; and

(2) even if they were somehow combined as stated by the Examiner there would still not result applicant's claimed invention.

Reference of Penney (US 471,891)

The wagon brake of Penney has (1) multiple pads of wood, or other suitable materials such as metal or rawhide, (2) pads that are slidably placed in transverse abutting arrangement within a recess in a brake shoe body, that is, normal to the axis of the contact plane, (3) a brake shoe that is curved to conform to the circular contact surface of the wagon wheel, and (4) a brake shoe that in use applies the brake pads directly to the ground contact surface of the wheel.

It is seen that in Penny there is no teaching of, suggestion of, or motivation for, (1) multiple pads of different elastomers having different braking characteristics, (2) pads that slide in the brake shoe in a direction parallel to the contact axis or surface plane, (3) a brake shoe having a planar contact surface but longitudinally curve in conformance with the curvature of the sidewall of the bicycle tire, and (4) a brake shoe having pads applied to the sidewall of the bicycle tire. Thus, in no way does Penney teach or suggests applicant's claim of invention. As clearly stated in Penny, "The object of my invention is to provide a brake shoe for road wagons, having a face which may be readily removed." The only similarity in the device of Penney and that of applicant's invention is that the brake means of Penney are replaceably installed entirely in a flanged recess in the casting of a brake shoe. There is absolutely no suggestion, much less a teaching, in Penney of the other teachings and claimed invention of applicant.

Reference of Everett (US 5,896,955)

The Examiner has relied upon the teachings of Everett of a bicycle brake pad having a plurality of pad segments, each having a contact surface for abutting a sidewall of a bicycle tire, with at least two of the pad segments being formed of a different elastomeric compound providing different frictional characteristics. However, Everett provides for engagement of one brake segment entirely within a second brake pad segment, and engagement with the sidewall is along an axis normal to the contact surface plane. A user would be required to either remove the brake pad from the bicycle or remove the wheel from the bicycle to remove and replace a pad segment along an axis normal to the contact surface plane.

The Everett brake pad, although composed of segments of differing compounds or having different textures, does not teach and does not feature brake pad segments which can conveniently be interchanged or replaced by the user. Because Everett teaches engagement of the segment with the brake pad along an axis normal to the contact surface plane, either the brake block or the wheel must be removed to interchange brake pad segments. The claims remaining in the case have been amended, directly or indirectly, to recite the claimed brake pad segments slide along a direction or axis parallel to the contact surface plane, which allows for replacement of pad segments without removal of the brake block or the bicycle wheel.

Everett discloses in one embodiment a main body brake pad with a removable insert portion totally enclosed by the main portion, the main body portion and the insert portion being of different braking compounds for providing different braking characteristics. In another embodiment (Figure 5) there is disclosed more than one brake pads of different braking compounds for providing different braking characteristics, there again being a main body portion with the pad portions formed entirely within the main body portion. The different pad portions are either formed as snap inserts in the main body portion or molded unitarily with the main body portion. There is absolutely no suggestion, much less a teaching, in Everett of, at least, the brake pad portions be individually molded as separate pads, or that such pads be longitudinally, sequentially and replaceably inserted into a recess in the brake shoe.

It is thus seen that there is absolutely no suggestion, much less a teaching, in Everett of the teachings and claimed invention of applicant.

COMBINATION OF REFERENCES

In support of applicant's submission that the combination of the references of Penney and Everett to show applicant's claimed invention is improper, the following is submitted.

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art and he can satisfy this burden only by showing some objective teaching in the prior art or that such knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references *In re Fine*, 837 F.2d 1071, 1074, 5USPQ2d 1596, 1598 (Fed. Cir. 1988).

The level of skill in the art is a prism through which a judge or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. See *W.L. Gore & Assoc. Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999).

As to rejection under 35 U.S.C. 103(a), the mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification *In re Gordon*, 723 F.2d at 902, 221 USPQ at 1127.

It has been variously held in *Ex parte Warhol*, 94 USPQ 193 and in *In re Irmscher*, 120 USPQ 196, that;

references may be combined to anticipate a claim, but their teachings must be capable of suggesting to one skilled in the art, without exercising inventive faculties, their combination in a manner disclosed in the claimed structure; and

the claim will be allowed where one skilled in the art, with the prior art before him, but in the absence of applicant's disclosure, would be incapable of constructing the claimed structure without displaying creative genius.

It is abundantly clear that there is absolutely no suggestion in either Penney or Everett of the desirability that the teachings of Penney could somehow be modified with the teachings of Everett to result in applicant's claimed invention. Thus, the Examiner has not met the requirement of any of the above cases and for this reason the Examiner's rejections must fail. Applicant has submitted that the Examiner has made a "hind-sight" rejection in that only with applicant's disclosure can one skilled in the art be capable of constructing applicant's claimed structure without exercising inventive faculties. In response the Examiner has cited *In re*

443 F.2nd 1392, 170 USPQ 209 (CCPA 1971) and stated that a hindsight reconstruction is proper so long as it takes into account only knowledge which was within the level of ordinarily skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure.

However, "Even if the level of skill in the art is so high that two references would make a claim of invention obvious if combined, high skill by itself provides no suggestion to combine the references. Absent a motivation to combine based on the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art, there is an inference that the references were selected by hindsight and a *prima facie* case of obviousness is not established." *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998).

It is therefore again submitted that the Examiner has not met the requirements for a rejection under 35 U.S.C.103(a) and has clearly made a "hind-sight" rejection in that only with applicant's disclosure can one skilled in the art be capable of constructing applicant's claimed structure without exercising inventive faculties.

Combination of Penney and Everett – Rejection under 35 U.S.C.103(a)

First, in view of the above, it is abundantly clear that there is no nexus between Penney and Everett such that the combination of their teachings would be capable of suggesting to one skilled in the art, without exercising inventive faculties, their combination in a manner disclosed in the claimed structure. Further, in view of the above it is clear that without applicant's disclosure one skilled in the art would be incapable of constructing the claimed structure without displaying creative genius.

As a simple example, if one takes the longitudinally curved brake shoe of Penney and replaces it with a transverse pad of Everett having inserts and/or moldings contained entirely within a body portion, the resulting device would not work since the different compounds would not engage the wheel surface simultaneously. Thus, the concept of turning the blocks of Penney 90% must be envisioned, otherwise the blocks would have to be each of different compounds, which is not taught by Everett. There still remains at least the concept of somehow modifying the device of Penney such that the brake shoe is planar and curved to be applied to the sidewall of the bicycle

tire. From this simple example it is seen that even if the teaching of Penney and Everett were somehow combined as vaguely suggested by the Examiner, there would not even result a workable device, much less applicant's claimed invention. Obviously the teachings of the claimed invention are necessary to somehow modify the device of Penney.

In view of the above, it is submitted that the Examiners burden has not been met under 35 U.S.C.103(a) in that the limitations contained in applicant's amended claims are neither taught nor suggested in Penney, Everett, or the combination thereof. It is thus respectfully requested that the Examiner's rejections be reconsidered and the claims in the case, that is amended independent claims 1, 8 and 15, and claims 2-5, 7-10, 12, 13, 15-17, 19 and 20 variously dependent therefrom, be allowed and the case passed to issue.

A petition for a two-month extension of time to reply, and a Request for Continued Examination (RCE) is enclosed along with forms PTO 2038 for the required fees of \$215.00 and \$395.00 respectively.

Respectively submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 04 October 2004.

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